

REMARKS

Claims 1-2 and 10-15 are pending and their status is as set forth in the "Amendment After Final Rejection..."

Request for Interview Prior to Formal Action on Amendment

Applicant requests an interview prior to formal action on this response. An "Applicant Initiated Interview Request Form" accompanies this response. Please contact Applicant's undersigned representative to schedule the interview.

Comments in Response to Advisory Action

1. Pending claims properly recite an article of manufacture and there is support in the original specification for an article of manufacture

In the Advisory Action, the Examiner provides the following explanation to justify not entering the "Amendment After Final Rejection..." (underlining added for emphasis):

...in reviewing the disclosure there is no support for the amended "article of manufacture." The addition of the phrase an "article of manufacture" in the preamble of the amended claims does not change the fact that the claimed invention is still a sheet of paper as defined by Applicant. The Applicant has defined the proofing paper as a sheet of paper..."

Applicant respectfully traverses the Examiner's statement that there is no support for claiming the present invention as an "article of manufacture."

The Appendix attached to this paper provides the current jurisprudence regarding the term "manufacture" in 35 U.S.C. § 101. All of the recognized definitions of "manufacture" clearly meet the item that is described in the original specification and shown in Fig. 2A and 3A. There is no requirement that the phrase "article of manufacture" appear in the original specification if Applicant chooses to characterize the invention as being an "article of manufacture" and such a characterization is consistent with the statutory interpretation of that phrase.

Referring to the Appendix, one accepted definition of “manufacture” is a comprehensive class of inventions that includes every article devised by man that is not a machine, a composition of matter or a design. See Appendix page A2. Another accepted definition is “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand labor or by machinery;” or “anything made for use from raw or prepared materials.” See Appendix pages A3 and A13.

Here, a sheet of paper that includes one or more standard color bars, among other characteristics, clearly meets the definition of a “manufacture” since raw or prepared material (here, a sheet of paper) is given new qualities or properties (here, one or more standard color bars). Furthermore, the claimed sheet of paper having a blank region and a marginal region that includes the one or more standard color bars was “devised by man.”

Applicant does not dispute the fact that the claimed article of manufacture comprises a sheet of paper as defined by Applicant. However, this fact does not preclude Applicant from characterizing the invention as an “article of manufacture.”

In sum, the amended preamble language is believed to be fully supported by the current jurisprudence regarding the term “manufacture” in 35 U.S.C. § 101 and its use in reciting a claimed item. Accordingly, no “lack of support” issue is raised by the new preamble language which was added to better characterize the appropriate statutory category of the claimed invention.

2. The claim language clearly defines the boundaries of the regions

In the Advisory Action, the Examiner provides the following comments (underlining added for emphasis):

...the claim language does not claim the invention...Regarding independent claims 1 and 12, Applicant still fails to define the boundaries of the regions (blank and marginal). For example, Applicant claims a marginal region “outside” of the blank region. This is not what is shown in the Applicant’s drawings. In the Applicant’s drawings (see figures 2A, 2B, 3A-3C), there is a blank sheet of paper (the blank sheet of paper is the blank region) and the marginal region with the color bar(s) is actually “inside” of the blank sheet of paper. Examiner has asked for this to be clarified in non-final Office action dated 28 September 2007 but Applicant

does not make any effort to define any region boundaries. This complicates examination since Applicant argues the location of regions in Examiner's applied prior art.

Applicant respectfully traverses the Examiner's understanding of the claimed invention. The Examiner's statement that the blank sheet of paper is the blank region is clearly refuted by the plain meaning of the word "blank." As discussed on page 8 of the "Amendment After Final..." the ordinary dictionary definition of "blank" means "devoid of writing, images, or marks."¹ There are no sheets of paper in any of Applicant's figures that are devoid of writing, images, or marks. Every sheet of paper in Applicant's figures has some type of writing, images, or marks on it. Thus, none of the sheets of paper in any of Applicant's figures are blank sheets of paper. The mere presence of a blank region on a sheet of paper does not transform the sheet of paper into a blank sheet of paper, even under the broadest interpretation of the claims. Stated simply, a blank sheet of paper must be blank, and if the sheet of paper is defined by multiple regions, then all of the regions must be blank. No such sheet of paper is described or claimed in the present application.

The Examiner's statement that the blank sheet of paper is the blank region is also clearly refuted by exemplary Figs. 2A and 2B and the plain language of exemplary claim 1.

Claim 1 recites that the sheet of paper includes (a) a blank region for subsequent printing of a content image portion, and (b) a marginal region outside of the blank region that includes one or more standard color bars. Claim 1 further recites that the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper. This configuration is exactly what is illustrated in Fig. 2A, with Fig. 2B providing additional understanding of what the claim language means (claims are interpreted in view of the specification). Fig. 2A shows a blank region for subsequent printing of a content image portion (the "SAMPLE PROOF" shown

¹ blank. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/blank> (accessed: September 12, 2008).

in Fig. 2B) and a marginal region² outside of the blank region (i.e., not encompassing the blank region) including one or more standard color bars (one standard color bar is shown in a marginal region of Fig. 2B). Together, these regions constitute the entire surface area of one side of the sheet of paper, exactly as shown in Fig. 2A.

The Examiner states that the blank sheet of paper is the blank region. However, this is not what claim 1 states, and this is not what Fig. 2A shows. Claim 1 recites that the sheet of paper includes a blank region and a marginal region outside of the blank region. "Includes" is an open-ended phrase, similar to "comprising."³ The Examiner's interpretation would be correct only if claim 1 recited that "the sheet of paper consists of a blank region." However, no such closed-ended language was used in the claim.

The Examiner further states that the marginal region with the color bar(s) is actually "inside" of the blank sheet of paper. This conclusion logically follows from the faulty presumption that the blank sheet of paper is the blank region. However, the Examiner's interpretation is incorrect as discussed above, and thus this conclusion is likewise incorrect. Furthermore, claim 1 explicitly states that the marginal region is outside of the blank region, thereby further refuting the Examiner's interpretation that the marginal region is inside of the blank sheet of paper.

The Examiner's underlying issue is that Applicant has failed to define the boundaries of the regions (blank and marginal). This is simply not the case. Exemplary claim 1 clearly recites a marginal region (i.e., a region of, relating to, located at, or constituting a margin, a border, or an edge) and that the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper. Fig. 2A shows one preferred embodiment of claim 1 wherein one

² As discussed in the paragraph spanning pages 9-10 of the "Amendment After Final Rejection...", Applicant is claiming a marginal region using the ordinary dictionary definition of "marginal," namely, "of, relating to, located at, or constituting a margin, a border, or an edge" (marginal. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/marginal> (accessed: September 12, 2008)). Furthermore, this ordinary dictionary definition is consistent with Applicant's disclosure which clearly shows a marginal region in Figs. 2A and 2B that is located at a margin or edge of the proofing paper.

³ MPEP 2111.03 Transitional Phrases
The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

color bar appears at a top margin, and the remaining portion of the sheet of paper is blank. Absent the presence of any prior art that reads on the claims (and none that reads on the claims has been applied to date as fully explained in the “Amendment After Final...”), there is no necessity or requirement for Applicant to further limit the claims to any specific boundary, such as stating that the marginal region constitutes the top 5% of the surface area of the sheet of paper from edge to edge, and the blank region constitutes the remaining 95% of the surface area of the sheet of paper. As long as no prior art reads on the claims and that the claims accurately reflect at least one preferred embodiment shown in the figures (and both of these conditions are met), Applicant is entitled to claim the invention as currently presented.

The Examiner further states that the failure to define the region boundaries complicates examination because Applicant argues the location of regions in the applied prior art. Applicant does not understand this statement. Applicant has merely argued in the previous responses that Chalmers fails to disclose or suggest the claimed invention. The Examiner has attempted to apply Chalmers to the claims by defining various regions in Chalmers’ test sheet and matching them up to the claimed regions. However, the regions in Chalmers highlighted by the Examiner simply do not match up to the claim language. For example, the Examiner states that a certain area of Chalmers’ test sheet is a “blank region.” However, the area that the Examiner highlighted is not blank. The only reason why the Examiner has been unable to apply the prior art of record to the claims is because it fails to disclose or suggest the claimed invention, not because the claims fail to define region boundaries.

3. Applicant’s claimed recitation of a marginal region outside of the blank region is well-understood in the printing arts

An artisan in the field of printing would understand exactly what the scope of the claims is directed to. It is well-known in the prior art to print color bars in the margins of a proof. See, for example, column 2, line 59 through column 3, line 3 of U.S. Patent No. 7,187,472 (Friedman et al.) which describes prior art color control processes wherein color bars are printed in a margin outside of the area of the printed image. This text portion of Friedman et al. is highlighted below for convenience (underlining added for emphasis):

A press operator may take a sample of a printed substrate with the color bars and place it in a test instrument. A typical instrument has a density scanning head traveling across the width of color bars. After scanning, the instrument displays density measurements on a computer screen. Upon examining the density values on display and also examining the printed sample, the operator makes necessary changes to the ink keys. This procedure is repeated until satisfactory print quality is achieved. Known methods for controlling printed colors have included the use of such a densitometer to measure the density of color bars printed in a margin outside the area of the printed image.

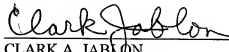
Applicant's claimed terminology is consistent with printing industry terminology, and thus there is no confusion regarding the scope of the claimed invention. Furthermore, Applicant's claimed embodiments, such as Fig. 2A, are consistent with such terminology.

Conclusion

The claims are believed to be patentable for the reasons stated in the "Amendment After Final." The comments given by the Examiner in the Advisory Action fail to rebut any of the previously given reasons for patentability. Accordingly, allowance of the application is respectfully requested.

Respectfully submitted,

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Enclosure: Appendix (14 pages)

APPENDIX

(attachment to Supplemental Remarks
for Application No. 10/822,617)

Jurisprudence regarding term “manufacture” in 35 U.S.C. § 101

A2-A5: Chisum on Patents, Mathew Bender & Company, a member of LexisNexis Group, September 2008, §1.02[3][a] Definition of a Manufacture.

A6-A8: Sammons & Sons v. Ladd-Fab, Inc., 221 USPQ 737 (Calif. Ct. App. 1982)

A9-A14: American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1 (1931)

in the final product after mixing.” She noted testimony by a patent practitioner who helped prosecute the patent that “claiming the composition in terms of amounts of additives is ‘a typical way it is done in connection with motor oil additives.’”³⁹ An employee of the accused infringer, when asked “to determine whether certain of its products infringed the European counterpart of” the patent in suit “performed the analysis by comparing the starting ingredients, not the final or intermediate products.”⁴⁰ Another employee, a lubricant formulator, “testified (although not in the specific context of interpreting claim language) that her concern as a formulator is ‘what goes in the pot.’”⁴¹ Finally, the patent examiner “found nothing technically wrong with the claim as a list of additives.”⁴²

[3] Definition of a Manufacture

Professor Robinson viewed “manufacture” as a “comprehensive class of inventions” that included “every article devised by man except machinery upon the one side, and compositions of matter and designs upon the other.”⁴³ Thus, it is the residual class of “product” patent—encompassing all man-made items not found in substantially the same form in nature that are neither machines nor compositions of matter.

Robinson’s approach was adopted in a number of court decisions⁴⁴ and could today be considered the accepted position but for the decision of the Supreme Court in *American Fruit Growers, Inc. v. Brogdex Co.* (1931).⁴⁵

[a] **Borax-impregnated Orange Case: *American Fruit Growers v. Brogdex* (1931).** In *American Fruit Growers, Inc. v. Brogdex Co.* (1931),⁴⁶ the Supreme Court addressed a patent that claimed “fresh citrus fruit of which the rind or skin carries borax in amount that is very small but sufficient to render the fruit

³⁹ 64 F.3d at 1567, 35 USPQ2d at 1812.

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² 64 F.3d at 1568, 35 USPQ2d at 1812.

⁴³ 1 W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890).

⁴⁴ *Johnson v. Johnston*, 60 F. 618 (W.D. Pa. 1894); *Sammons & Sons v. Ladd-Fab, Inc.*, 221 USPQ 737 (Calif. Ct. App. 1982).

See also *In re Bergy*, 596 F.2d 952, 201 USPQ 352 (CCPA 1979), *aff’d sub. nom. Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980), discussed § 1.02[7][d]; *Binney & Smith Co. v. United Carbon Co.*, 125 F.2d 255, 52 USPQ 205 (4th Cir. 1942), *rev’d on other grounds*, 317 U.S. 228 (1943); *American Patent Dev. Corp. v. Carbice Corp.*, 38 F.2d 62, 64, 4 USPQ 141 (2d Cir. 1930), *rev’d on other grounds*, 283 U.S. 27 (1931).

⁴⁵ *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1 (1931).

⁴⁶ *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1 (1931).

resistant to blue mold decay.”⁴⁷ The Court held that an orange impregnated with borax is not a “manufacture” within the meaning of the Patent Act. However, the reasoning in the Court’s opinion is very weak. It quotes a dictionary definition of “manufacture” as “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations. . . .”⁴⁸ It then reasons that “the addition of borax to the rind of natural fruit does not produce from the raw material an article for use which possesses a new or distinctive form, quality, or property.”⁴⁹ “There is no change in the name, appearance, or general character of the fruit. It remains a fresh orange, fit only for the same beneficial uses as theretofore.”⁵⁰ This argument is simply erroneous as a matter of fact. An impregnated orange may look the same and taste the same as a natural orange, but it is not chemically the same. An impregnated orange is also fit for new “beneficial uses,” if the patentee’s statements are to be believed. It is a product that can be shipped and stored with less danger of blue mold.

The Court also relied on two of its prior decisions, neither of which concerned patent law. *Hartranft v. Wiegmann* (1887)⁵¹ concerned a tariff statute that imposed a duty of 35% on “shells, manufactures of” but exempted “shells of every description, not manufactured.” The court held that shells which were cleaned with acid and polishing on an emery wheel were not manufactured because they had no “distinctive name, character, or use” different from an ordinary shell.

Aneheuser-Busch Brewing Ass’n v. United States (1908)⁵² concerned another tariff statute which allowed a rebate of duties paid on imported materials “used in the manufacture of articles manufactured in the United States,” which articles are then exported. The Court held that corks imported, cleaned, treated, and then inserted in bottles of beer for export were not such materials: “Manufacture implies a change, but [not] every change is . . . manufacture There must be transformation A cork put through the claimant’s process is still a cork.”⁵³

Neither decision should properly be considered a precedent for the meaning of “manufacture” in patent law. The purposes of tariff and patent statutes are, of course, radically different. It is clearly fallacious to assume that a single term such

⁴⁷ U.S. Pat. No. 1,529,461.

⁴⁸ 283 U.S. at 11.

⁴⁹ 283 U.S. at 11.

⁵⁰ 283 U.S. at 12.

⁵¹ *Hartranft v. Wiegmann*, 121 U.S. 609 (1887).

⁵² *Aneheuser-Busch Brewing Ass’n v. United States*, 207 U.S. 556 (1908).

⁵³ 207 U.S. at 206–207.

as “manufacture” must have a single meaning in law.

It must be concluded that the *American Fruit Growers* treatment of the meaning of “manufacture” is of little or no precedential value.⁵⁴ No patent law policy is served by requiring that a product differ in name, appearance, or general character from natural products or existing products in order to qualify as a “manufacture.”⁵⁵ The presence or absence of a “new or distinctive form, quality or property” is an issue properly relevant to the statutory standards of novelty and nonobviousness.

In *Diamond v. Chakrabarty* (1980),⁵⁶ the Court quoted the *American Fruit Growers* definition but apparently found it compatible with a broad view of the concept of a manufacture. In holding that a genetically-altered living microorganism qualifies as patentable subject matter, the Court cited legislative history accompanying the 1952 Act that suggested that statutory patentable subject matter would include “anything under the sun that is made by man.”

Lower court and administrative decisions since *American Fruit Growers* distinguish its holding.⁵⁷

Steinfur Patents Corp. v. William Beyer, Inc. (1932)⁵⁸ concerned an improvement in the art of bleaching and dyeing furs. A process patent claimed a method of treating unbleached skins, bleaching them and then dyeing the bleached skins. The process allowed use of cheaper dark-colored furs to make the more desirable white and light-colored furs. A product patent claimed skins that had been impregnated with the protective solution but not bleached, skins that had been bleached after impregnation, and skins that had been impregnated, bleached and dyed according to the process. The defendant urged that the described skins did not constitute “manufactures,” citing *American Fruit Growers*. The court distinguished *American Fruit Growers* and upheld the patent.

“In none of the three stages sought to be protected by the present patent were the dressed skins in their natural state. While it was true of the orange that impregnation of its rind with borax only protected the natural article against deterioration by mold and gave it no new beneficial uses, the same

⁵⁴ The court held as an alternative holding that the patent was invalid for lack of novelty. This was a much sounder basis of decision.

⁵⁵ For a discussion of “products of nature,” see § 1.02[7].

⁵⁶ *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980), discussed § 1.02[7][d].

⁵⁷ *Steinfur Patents Corp. v. William Beyer, Inc.*, 62 F.2d 238 (2d Cir. 1932), discussed below; *Ex parte Mowry*, 110 USPQ 389 (Pat. Off. Bd. App. 1955), discussed below.

But cf. *Bayer Ag v. Housey Pharmaceuticals, Inc.*, 340 F.3d 1367 (Fed. Cir. 2003), discussed below and § 16.02[6][d][iv][B].

⁵⁸ *Steinfur Patents Corp. v. William Beyer, Inc.*, 62 F.2d 238 (2d Cir. 1932).

cannot be said of impregnation of the unbleached skin with ferrous sulphate. By such impregnation the skin attains a new quality which gives it a new beneficial use; it fits it to be used for bleaching by a method which could not without such impregnation be successfully employed. An orange has the same use whether or not impregnated with borax. A fur skin unimpregnated with ferrous sulphate cannot be used in the same way as one which has been so impregnated.”⁵⁹

Similarly, *Ex parte Mowry* (1955)⁶⁰ concerned a claim for “erosion-stable soil which comprises a natural soil containing on the surface thereof a substantially continuous film of a water-soluble polymer” of a specified compound. The Board held that such a claim was for a “manufacture” and distinguished *American Fruit Growers*: “[H]ere the polymer is adsorbed by electrolytic phenomena on the soil particles and the individual soil particles are chemically bound to form an erosion resistant but water pervious layer on the surface of the soil. Such soil is quite distinct from untreated soil.” The Board also noted that “[W]e do not find anything in the definition of manufacture which requires that it be transportable or packaged as an article of commerce.”⁶¹

[b] “Kits” with Components for Assembly. In *In re Venezia* (1976),⁶² the Court of Customs and Patent Appeals held that a claim for a “kit having component parts capable of being assembled in the field” constituted patentable subject matter as a “manufacture.”

“To hold that the words ‘any manufacture’ exclude from their meaning groups or ‘kits’ of interrelated parts would have the practical effect of not only excluding from patent protection those ‘kit’ inventions which are capable of being claimed as a final assembly . . . but also many inventions such as building blocks, construction sets, games, etc., which are incapable of being

⁵⁹ 62 F.2d at 240.

⁶⁰ *Ex parte Mowry*, 110 USPQ 389 (Pat. Off. Bd. App. 1955).

See also *Ex parte Shepherd*, 185 USPQ 480, 485 (Pat. Off. Bd. App. 1974).

⁶¹ 110 USPQ at 390.

⁶² *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

See also *Ex parte Sudan*, 224 USPQ 614, 615 (Bd. App. 1983) (Claim to “two container pack” of ingredients for mixing to form a foam is not improper; “The difference that in *Venezia* the kit, when assembled, may readily be disassembled whereas here the foam produced cannot be reformed to its original constituent parts palpably is a difference irrelevant insofar as compliance with Section 112 of the Statute is concerned.”); *Ex parte Wolters*, 214 USPQ 735 (PTO Bd. App. 1979) (rejection of claim to “test pack” of several antibodies as not for an “integral structural unit” reversed).

Compare *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004), discussed § 1.02[4] (kit comprising instructions for carrying out a method and a suitable reagent; anticipation by prior art showing kit with different instructions and the reagent).

the time the application was filed (January 20, 1975) may be classified as a paper wiping towel encompassed within the prohibition of the contract.

[2] When the application was filed, applicant was applying the mark KIMTEX to a variety of products, including but not limited to, low based filters, classified in International Class 16. Indeed, that was the intended description of goods set forth in the application when the mark was published for opposition in 1975. That composition of applicant's application was altered by the discovery deposition of William A. Dicksen, Jr., a sales representative of the defendant's employees. See Dicksen dep. at 19-20, 29.

Wherein the witness testified that the KIMTEX product on the market consisted of two components, one of which was 100% cellulose. See also Zierk dep. exhibit 29. The defendant's position is that applicant subsequently discontinued marketing this product under the KIMTEX mark in August 1976 and reintroduced the mark on a product of different composition. See, e.g., Zierk testimony dep. 16, and exhibit 35 to Zierk's discovery deposition. This applicant amended the description of the goods in the application in its application after publication and just prior to the filing of the instant opposition, that is, to the filing of non-woven fabric articles, namely, wiping cloths, in [International Class 24 (fabrics)], must be so construed to encompass the goods covered in the application. The goods filed in the application, in which the mark was used at the time the application was filed were at least in part composed of cellulose, we believe they fall

¹ Cellulose is defined in Webster's Third New International Dictionary (1976) as:

"any of several fibrous substances constituting the chief part of the cell walls of plants, especially many fibrous products (as paper, cotton, linen) derived from plants, especially from woody tissue (as burl) (as wood or cotton linters) by purification (as by soda ash or other chemical treatment) and use-1 esp. in making regenerated cellulose products (as rayon and cellophane) and cellulose ethers (as carboxymethyl cellulose and carboxymethyl cellulose ethers)." ...

*To do otherwise would render this application void since it would seek registration of a mark for goods not in existence at the time of filing the application.

Applicant's second KIMTEX product, distributed from 1976 on, is neither strictly a textile product nor a paper product. It is a nonwoven fabric produced using melt-blown polypropylene (a typical linear, thermoplastic resin). Applicant's manager of industrial product development testified that melt-blown fabric was unrelated of in the 1920's. Cook dep. 32.

*This is not to say that applicant's current KIMTEX product is a paper towel. The nonwoven KIMTEX product, with its absorbency, durability, and texture and other characteristics, is designed to replace retail cloth towels and rag-Zierk dep. 32.

them, have been used, promoted and advertised together so as to create recognition by purchasers that the marks common origin. This evidence demonstrates that the "text" mark is quite commonly used in the paper towel industry and that the parties have been exchanging goods numerous third-party marks. This evidence tends to demonstrate that opposer does not enjoy an exclusive right to the suffix "tex," and that purchasers are likely to look to the remaining parts of the mark to distinguish source. The established likelihood of confusion has not been established.

We agree with applicant that opposer's evidence falls short of establishing such use by promotion as a family of marks. Opposer's testimony offered by opposer has established part of a family is that of N. Newton Inlander, the president of Inlander Brothers, Inc., a paper merchant. However, it is clear from his testimony that his conclusion that there should be confusion as to source arose from use of KIMTEX on the cover of a book. This conclusion is based upon the similarity of stock numbers on products of the respective parties. (Inlander dep. 15). In addition, Mr. Inlander stated that he was quite sure that his count and that he never stocked the KIMTEX products of any confusion. He had no knowledge of the stipulated record in this case according to the stipulated record (applicant's exhibit 5), nearly 500 cases of KIMTEX towels had been stocked by the Inlander company within a five-month period prior to the taking of his deposition. This evidence together with opposer's statement that there are reports of confusion as to their amongst his employees casts doubt on his conclusion that the KIMTEX mark and opposer's "family" of marks would cause confusion.

[5] Moreover, applicant has introduced credible evidence of the use by third parties of marks containing the "tex" element on or in connection with closely related paper products. Applicant has relied upon the discovery depositions of a number of third party marks. There is evidence that goes in for many years ago KIMTEX for bathroom tissue, paper towels, napkins, facial tissue and paper towels. SORETEX for paper towels, SPINTEX for disposable industrial wiping cloths, VELTEX for wiping cloths, and SUPTX for paper

TEK, PROTEX, and SUPTX for paper

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toilet seat covers; FIBRETEX for industrial towels; SNOWTEX for wrapping tissue; DIFTEX for nonwoven wipers, and others. This evidence demonstrates that the "text" mark is quite commonly used in the paper towel industry and that the parties have been exchanging goods numerous third-party marks. This evidence tends to demonstrate that opposer does not enjoy an exclusive right to the suffix "tex," and that purchasers are likely to look to the remaining parts of the mark to distinguish source. The established likelihood of confusion has not been established.

Decision

In view of our holding that applicant is precluded by the 1924 agreement from seeking registration of the "text" opposition is sustained and registration to applicant is refused.

California Court of Appeals, Second Appellate District

Sammons & Sons v. Ladd-Fab, Incorporated
No. 63106

Decided Dec. 21, 1982

UNFAIR COMPETITION

1. In general (§68.01)

Sears, Roebuck & Co. v. Stiffel Co., 140 USPQ 524, and Compco Corp. v. Dayco Corp., 140 USPQ 528, describe misappropriation of trade secrets solely upon copying of matter in public domain.

2. In general (§68.01)

Because of federal patent laws, state may not, when article is unpatented, prohibit copying, righted, prohibit copying article itself or award damages for such copying, state law

*The search reports and trade directories listing marks and entities containing the "tex" element are incompetent by themselves to prove that the public marks and trademarks are identical to the trademarks of the defendant. Angelica Corp. v. Collins & Almaran Corp., supra at 393.

*During this proceeding the parties stipulated that the discovery depositions and exhibits of third parties may be used at trial by the filing of notices of reliance. See stipulation filed June 16, 1979.

may not forbid others to copy article that is unprotected by patent or copyright.

COPYRIGHTS

3. Matter copyrightable — Clauses in statute (§24.303)

Whether any specific category of writings is to be brought within purview of federal statutory scheme is left to discretion of Congress; catalog is works of authorship within federal copyright law; USC §102 extends copyright protection to literary works; term "literary works" does not connote any criterion of literary merit or qualitative value; it includes catalogs, directories, and similar factual, reference, or instructional works and compilations of data.

PATENTS

4. Patentability — Subject matter of patent monopoly — In general (§51.601)

"Manufacture," as used in patent law, has very comprehensive sense, embracing whatever is made by art or industry of man, not including machine, composition of matter, or design.

UNFAIR COMPETITION

5. In general (§68.01)

Whole competitive scheme is actionable when free copying is accomplished by misappropriation outside scope of copying.

Appeal from California Superior Court, Los Angeles County, Western Division. Action by Sammons & Sons against Ladd-Fab, Incorporated, for unfair competition. From order sustaining defendant's demurrer, plaintiff appeals. Affirmed.

GARY L. March and Cayer Johnson & Westrop, both of Long Beach, Calif., for appellant.

GARY E. Lande, William J. Robinson, Pons, Smith, Lande & Rose, all of Los Angeles, and Harry S. Rubin and Beverly H. Rubin, all of Beverly Hills, Calif., for respondent.

Before Potter, Acting Presiding Justice, and Lui and Dacting, Justices.

Potter, Acting Presiding Justice.

Plaintiff Sammons & Sons appeals from a judgment dismissing its action against defend-

dant Ladd-Fab, Inc., after defendant's demurrer to plaintiff's "Complaint for Money Damages, Accounting of Profits, and Permanent Injunctive Relief on Account of Unfair Competition and Unfair Practices; and for Declaratory Relief" was sustained without leave to amend.

The complaint comprises four causes of action. However, only the first cause of action alleges any facts purportedly constituting a violation of plaintiff's rights; the remaining three causes of action are based on allegations and seek different relief based on the gravamen of plaintiff's unfair competition claim, as stated in the first cause of action, is, as follows: Commencing in 1957, plaintiff engaged in manufacturing, fabricating, constructing, designing, merchandising, and distributing a wide variety of storage components utilized in connection with warehousing and other storage of goods. These components were original and unique of conception and design and had both functional and nonfunctional features which distinguished them from other similar products. Plaintiff desired to protect its investment in advertising, market and merchandise them so as to create a consumer demand throughout California and elsewhere in the United States. These components became widely known and plaintiff acquired a prominent position in the storage component industry. In 1978, defendant became a distributor of plaintiff's components and thereby acquired a supply of them, as well as technical and other literature compiled by plaintiff relating thereto. In 1980, defendant commenced selling, distributing, merchandising, and promoting plaintiff's components and, using plaintiff's designs, engineering, and marketing of storage components "substantially all of which components were and are exact reproductions and duplications of the metal and other storage components heretofore manufactured, marketed, constructed, designed, and distributed by plaintiff and Plaintiff" and published and distributed "a certain catalog reflecting the entire product line of Ladd-Fab, all of which product line was and is an exact duplicate, reproduction, and replica of Plaintiff's product line," which defendant also sold and distributed, thereby reproducing and duplication of the catalog reflecting the product line of Plaintiff ***

Copies of the respective catalogs are attached. The complaint then characterizes defendant's actions in duplicating plaintiff's entire product line and its catalog as "unfair competition."

Section 17200 of the California Business and Professions Code. Plaintiff's demand that defendant cease the sale of its reproductions

and the publishing, and distributing of its catalog were rejected.

Defendant's demurrer was based solely on the ground that the complaint fails to state facts sufficient to constitute a cause of action.

Before making its order, the trial court indicated its view that no cause of action was stated and offered plaintiff the opportunity to amend, but suggested that if plaintiff had taken its "best shot," it might prefer to leave the matter to the court. Plaintiff chose this alternative.

The court's ruling was premised directly and entirely upon the propositions that (1) federal law has completely preempted state law relating to the copying of unpatented and uncopyrighted matter coming within the purview of federal law, the copying of plaintiff's unpatented and uncopyrighted catalog is permissible; and (2) such copying cannot lawfully be unfair competition under California law.

Contentions

Plaintiff concedes that "[t]he basic premise of Sears and Compco," both decided on the same day, is that "when an article is unprotected by a patent or copyright, state law may not forbid others to copy that article because whatever the federal patent and copyright laws leave in the public domain," Plaintiff claims, however, that despite this limitation, a cause of action survives under state law for "misappropriation" of plaintiff's "many years of development and research" and that such cause of action is not preempted by federal law. Alternatively, plaintiff contends that its complaint shows plaintiff's entitlement "to equitable relief from the trial court with respect to making [defendant] identify distinctly the source and origin of its products." Defendant contends both of plaintiff's said contentions.

Discussion

Summary

[I] No cause of action for "misappropriation" exists under state law where the subject matter is in the public domain. Sears and Compco proscrib[e] misappropriation claims

based solely upon such copying. Plaintiff's complaint alleges no facts other than lawful copying of its catalog and of the work of its employees in creating, both of which are in the public domain.

The complaint likewise omits any facts suggesting that defendant has failed to identify the source and origin of its products.

No Misappropriation Allowed Cause of Action Alleged

The complaint, which plaintiff agreed was its "best shot," alleges that defendant's products and its catalog descriptions were developed as the result of plaintiff's large expenditure and thereby benefiting from plaintiff's efforts. Fairly characterized, the complaint alleges an appropriation of plaintiff's efforts. The complaint does not allege, however, in that it alleges no facts which show that such appropriation was wrongful, that is, that it was a "misappropriation." Plaintiff does not deny that both its products and the work of authorship in its catalog are in the public domain. Plaintiff and Compco, both decided in the same case, held that the federal patent and copyright laws require "free access to copy" that which is in the public domain. The obvious conclusion is that an appropriation accomplished solely by a copying which is lawful under the federal patent and copyright laws, cannot be a misappropriation.

To avoid this conclusion, plaintiff (1) frontally attacks the Sears and Compco cases and (2) asserts continued validity of a misappropriation cause of action where the free copying is accompanied by "misappropriation" *** outside the scope of copying.

[L] Little purpose would be served by purporting to distinguish between "misappropriations." As our Supreme Court said in *Auto Equity Sales, Inc. v. Superior Court* (1962) 57 Cal.2d 450, 455: "Under the doctrine of stare decisis, all tribunals exercising inferior jurisdiction are required to follow the precedents of the superior courts." What the United States Supreme Court holds as to the preemptive effect of the federal patent and copyright laws cannot be overruled by this court. We are, therefore, bound by the rule as stated by the United States Supreme Court in *Auto Equity Sales, Inc. v. Superior Court*, 332 U.S. 157, 167, 48 S.Ct. 232-233, 140 USPQ at 528 that "because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying."

¹ Sears, Roebuck & Co. v. Stiffel Co. (1964) 376 U.S. 255, 258, 140 USPQ 524, and Compco Corp. v. Day-Brite Lighting (1964) 376 U.S. 234, 140 USPQ 528 & 531.

U.S. Supreme Court

American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1 (1931)

American Fruit Growers, Inc. v. Brogdex Co.

No. 48

Argued January 9, 12, 1931

Decided March 2, 1931

283 U.S. 1

CERTIORARI TO THE CIRCUIT COURT OF APPEALS

FOR THE THIRD CIRCUIT

Syllabus

1. Patent 1,529,461, to Brogden and Trowbridge, claiming a new and improved process of preparing fresh fruit for market by subjecting it to the action of a solution of borax, and thus, through the fungicidal properties of that chemical, rendering it resistant to the decay caused by blue mold, and also claiming, as a product, fresh citrus fruit of which the rind carries borax of small amount, but sufficient to render the fruit resistant to such decay, is invalid because the process was anticipated and the product is not within the patent law. Pp. 283 U. S. 11, 283 U. S. 13.

2. The claim of a patent must be explained by and read in connection with the specification. P. 283 U. S. 6.

3. An orange, the rind of which has become impregnated with borax through immersion in a solution, and thereby rendered resistant to blue mold decay, is not a "manufacture" or manufactured article within the meaning of the patent law, U.S.C. Title 35, § 31. P. 283 U. S. 11.

4. A patent claim is not novel if it would be infringed by following a process described in an earlier patent or if the substance of the thing claimed by the later patent was disclosed by the earlier one. P. 283 U. S. 14.

35 F.2d 106, reversed.

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Certiorari, 281 U.S. 709, to review a decree which affirmed the district court, 21 F.2d 110, in adjudging that the patent of the present respondent was valid and was infringed by the petitioner.

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MR. JUSTICE McREYNOLDS delivered the opinion of the Court.

The Brogdex Company, present owner of United States letters patent No. 1,529,461, relating to "certain new and useful improvements in the art of preparing fresh fruit for market," applied for August 13, 1923, and issued to Brogden and Trowbridge March 10, 1925, presented its bill of complaint to the District Court for Delaware April 15, 1926, wherein it charged that the defendant (petitioner

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here), the American Fruit Growers, Inc., had infringed and asked an injunction, accounting, damages, etc. It relied upon Claims Nos. 1, 2, 3, 4, 5, 6, 7, 9, 14, 15, 16, 17, and 18, which describe the process of treatment, also Nos. 23, 24, 25, and 26, which concern the product.

Both courts below held all of these claims valid and infringed, and directed that petitioner be enjoined from using any process therein specified, also from manufacturing, selling, or using "treated fruit embodying and containing the invention described in said letters patent and secured by any of said [product] claims."

Of the process claims, the following is characteristic:

"3. In the preparation of fresh fruit for market, the process which comprises subjecting fruit to the action of an aqueous solution of borax, the fluidity, strength and temperature of the treating solution, and the duration of the treatment, being such that exposed rind or skin tissues of the fruit are effectively impregnated with borax and rendered resistant to blue mold decay, while at the same time the fruit is not scalded nor is its freshness or edibility otherwise substantially impaired."

The following is typical of the product claims:

"26. Fresh citrus fruit of which the rind or skin carries borax in amount that is very small but sufficient to render the fruit resistant to blue mold decay."

"The claim of a patent must always be explained by and read in connection with the specification." *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 185 U. S. 432.

The specification in respect of the patent states:

"This invention relates to art of preparing fresh fruit for market, and in particular it relates to processes for the treatment of citrus and other fruits in such manner that the development of molds and the like upon the fruit, and especially the development of blue mold and infection by blue mold spores, is prevented or arrested either wholly or to such large extent as greatly to prolong

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the marketable life of the fruit beyond what has been possible heretofore; the complete treatment most desirably also including a step of providing the fruit with a very thin film-like coating of protective material comprising a waxy substance such as paraffin, all as will more fully hereinafter appear."

"The greatest present utility of the invention is in the treatment of citrus fruits such as oranges, grapefruit, lemons, tangerines, etc.; also apples and other fruits that are attacked by blue mold or the like. The invention is broad, however, and the term fruit as herein employed is to be understood as not necessarily restricted to fruit in the sense in which the word is usually employed, but is to be understood broadly as including not only fruit proper, but also vegetables, such as tomatoes or the like, that can be treated to advantage in accordance with the principles of the invention to be hereinafter set forth."

"For the sake of a concrete example whereby the principles of the invention may be illustrated and explained, reference will be made hereinafter more particularly to the treatment of citrus fruit, especially oranges and lemons, which are especially subject to attack and destruction by blue mold. It is a well known fact that a large part of the losses from decay in the marketing of various fruits, such as citrus fruits and apples is attributable directly to the action of blue mold.

The problem of how to suppress or control blue mold development on fruits has been the subject of extensive and careful investigation, but admittedly no thoroughly satisfactory solution of the problem has heretofore been offered. In spite of elaborate precautions taken in the handling and transportation of fruits to market, it is not uncommon for shipments of oranges and the like to arrive at marketing points showing in some cases as much as 30 to 40 percent decay directly attributable to blue mold. The various investigations of the subject have shown that, while blue mold

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does not ordinarily attack perfectly sound fruit that is free from bruises, cuts, thorn-pricks or punctures, the slightest surface cut or scratch affords a point of attack by providing lodgment for blue mold spores, which develop with great rapidity and soon bring about complete destruction of the infected fruit. . . ."

"The present applicants have discovered that, by proper treatment of the fruit in the packing house, it is possible to greatly reduce, and often to absolutely prevent, the growth or development of blue mold on fruit for long periods of time, and thus to materially lessen or even eliminate the heretofore unavoidable losses from decay. Moreover, it is possible to achieve these results without upsetting or greatly changing present practice so far as concerns the mechanical handling of fruit in packing houses of the modern type. Thorough practical tests of the novel processes have demonstrated conclusively that, by proceeding in accordance with the invention, blue mold development can be arrested and fruit can be rendered immune to attack by blue mold spores in a simple and effective manner without affecting the freshness and flavor of the fruit, the marketable life of the fruit being thus prolonged far beyond that of untreated fruit. In view of the well known persistent activity of blue mold spores even under conditions fatal to the parent mold, the importance of this achievement is obvious. In general, the process of the invention involves applying to the fruit a mold-inhibiting reagent comprising the boric acid radical, said compound being most desirably alkaline in reaction and being employed in concentration effective to render the surface of the fruit unfavorable as a medium for blue mold development. Ordinary borax ($\text{Na}_2\text{B}_4\text{O}_7 \cdot 10\text{H}_2\text{O}$) has been found, after extensive investigation, to be especially potent in its retarding and inhibiting action in this connection, and this substance is considered at present to be the most desirable to employ

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in practicing the invention. A water solution of borax is alkaline in reaction, but is without corrosive or other deteriorating action upon fruit to which it is applied. Boric acid is not so effective as a mold-retarder as is borax, but compounds of boron, whether acid or alkaline, appear to have a specific inhibiting action upon blue mold, and hence it is not desired to limit the invention, so far as concerns compounds of boron, to the employment of an alkaline treating solution."

"The method of applying the treating solution to the fruit may assume various specifically different forms, the precise details of procedure being not essential to the invention in its broader aspects. However, where it is desirable, as may often be the case, to carry out the process without changing prior practice any more than is strictly necessary, the application of the mold-retarding agent may be effected as a part of or in conjunction with the usual washing operation to which the fruit is initially subjected in its handling according to modern packing house methods, especially as most of the mold-retarding agents herein contemplated also have excellent

cleansing or detergent properties. Accordingly, in the practice of the invention, the mold-retarding agent, borax in a specific instance, may be added in proper mold-inhibiting quantity directly to the wash water in the usual soaking tank into which the fruit is dumped from the field boxes as it comes from the groves. . . ."

"From this point on, the handling of the fruit in further preparation for boxing and shipment may or may not involve additional preservative treatment in accordance with the principles of the invention. This depends upon whether or not the fruit is to receive an application of protective coating material for the purpose of preventing or reducing shrinkage and withering and of ensuring conservation of the original freshness and flavor of the fruit for prolonged periods of time. Generally this further

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treatment is highly desirable, and if the benefits of the invention are to be realized to the fullest extent, this further treatment should be carried out. It consists in applying to the fruit a normally solid protective material, especially paraffin or like waxy material, in such condition that it can be spread all over the surface of the fruit to produce an extremely thin protective film which is not noticeable except by the expert eye and does not interfere with the so-called breathing or transpiration of the fruit to an undesirable extent, but which is effective to conserve the original plumpness and freshness of the fruit as above stated. . . ."

"In the foregoing disclosure of the principles of the invention, reference has been made more particularly to blue mold as a source or cause of decay. Such reference to blue mold is to be taken not as restrictive, but as generic and as intended, both in the specification and in the claims, to cover not only blue mold but all kindred rot and decay organisms and diseases generally amenable to treatment in accordance with the invention, to which fruit is or may be susceptible and by which it may be damaged under the conditions prevailing in packing and marketing. . . ."

Petitioner admits ownership of plants which pack and sell citrus fruits, and that, when preparing these for market, it caused them to be dipped in a borax solution in order to prevent or retard decay incident to growth of blue mold. Under the treatment applied, the raw fruit is immersed in a cold or warm solution of borax or boric acid, permitted to remain until thoroughly wet, then rinsed, dried, and brushed. Infringement is admitted, if the patent is valid.

In defense, petitioner maintains that the product claims of the patent fail to describe an article of manufacture within the meaning of the statute. Also that the process

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claims are invalid for various reasons, among them anticipation by United States letters patent No. 683,899, issued October 8, 1901, upon application of Simeon Bishop.

Is an orange, the rind of which has become impregnated with borax, through immersion in a solution, and thereby rendered resistant to blue mold decay, a "manufacture," or manufactured article, within the meaning of § 31, title 35, U.S.Code?

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented . . . may . . . obtain a patent therefor."

Answering affirmatively, the circuit court of appeals said:

"The product claims define an article of manufacture, since the fruit is the result of a process which is defined and described, and not a natural product. The product is a combination of the natural fruit and a boric compound carried by the rind or skin in an amount sufficient to render the fruit resistant to decay. The complete article is not found in nature, and is thus an article of manufacture. *Riter-Conley Mfg. Co. v. Aiken et al.*, 203 F.6d 9."

This position, we think, is not tenable.

"Manufacture," as well defined by the Century Dictionary, is

"the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand labor or by machinery;" also "anything made for use from raw or prepared materials."

Addition of borax to the rind of natural fruit does not produce from the raw material an article for use which possesses a new or distinctive form, quality, or property. The added substance only protects the natural article

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against deterioration by inhibiting development of extraneous spores upon the rind. There is no change in the name, appearance, or general character of the fruit. It remains a fresh orange, fit only for the same beneficial uses as theretofore.

In *Hartranft v. Wiegmann*, 121 U. S. 609, 121 U. S. 613, this Court considered the meaning of the words "manufactures of shells," and held that "cleaning off the outer layer of the shell by acid, and then grinding off the second layer by an emery wheel, so as to expose the brilliant inner layer," did not convert it into a manufacture.

"The shells in question here were not manufactured, and were not manufactures of shells, within the sense of the statute imposing a duty of 35 percentum upon such manufactures, but were shells not manufactured, and fell under that designation in the free list. They were still shells. They had not been manufactured into a new and different article, having a distinctive name, character, or use from that of a shell. The application of labor to an article, either by hand or by mechanism, does not make the article necessarily a manufactured article, within the meaning of that term as used in the tariff laws. Washing and scouring wool does not make the resulting wool a manufacture of wool. Cleaning and ginning cotton does not make the resulting cotton a manufacture of cotton."

And in *Anheuser-Busch Brewing Assn. v. United States*, 207 U. S. 556, 207 U. S. 562, where it was claimed that corks for bottles which had undergone special treatment after importation thereby became articles manufactured in the United States, this Court said:

"Manufacture implies a change, but every change is not manufacture, and yet every change in an article is the result of treatment, labor, and manipulation. But something more is necessary, as set forth and illustrated in *Hartranft v. Wiegmann*, 121 U.S.

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609. There must be transformation; a new and different article must emerge 'having a distinctive name, character, or use.'"

If it be assumed that the process claims under consideration cover an invention, we think this lacked novelty when application was made for the patent August 13, 1923. The underlying conception had been adequately revealed in Bishop's patent of 1901.

He claimed:

"1. The method of treating articles of food to preserve and enhance their value, which consists in washing them with a solution of boracic acid and then applying a coating of gelatin, substantially as described."

"2. The method of treating articles of food to preserve and enhance their value, which consists in washing them with a solution of boracic acid and then applying a coating of gelatin, and finally wrapping the article in tissue paper which has been impregnated with a solution of boracic acid, substantially as specified."

And, in the specification, he affirmed:

"This invention aims to prolong the period of usefulness of fruit, vegetables, eggs, and the like as articles of food and prevent their usual rapid decay and deterioration, thereby benefiting the grower, the shipper, the merchant, and the consumer."

"The invention consists in subjecting the article of food to an antiseptic bath of purify, cleanse, and kill all germs, then treating it to a coat of air-excluding material. This process not only preserves the articles of food, but enhances its value. . . ."

"The application of boracic acid is advantageous in that it prevents decay and adds to the appearance of the article and is perfectly harmless to the human system. The gelatin, besides excluding the air, also adds to the appearance of the article. . . ."

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That boracic (boric) acid -- a weak acid -- and borax, with an alkaline reaction, inhibit the rapid development of blue mold has long been known. Both are compounds of boron, and contain the "boric acid radical." Their antiseptic quality is due to the presence of that element. For present purposes, the two must be regarded as equivalents, and the mere substitution of one for the other would not involve invention or avoid infringement. Walker on Patents, 6th ed., § 426.

Read together, the claims and specification of the Bishop patent show that he intended it should have wide application and cover treatment of citrus, as well as other, fruits. He distinctly states the application of boracic acid prevents the usual rapid decay, and upon this basic fact respondent endeavors to support the patent in suit.

True, Bishop proposed as a secondary step the application of gelatine which he averred would exclude the air and enhance the appearance of the article. But Brogden and Trowbridge also said in their specification that, "if the benefits of the invention are to be realized to the fullest extent," the fruit after being soaked should receive an application of protective coating material, such as paraffin, or like waxy material. If the claims of the patent in suit are valid, one operating under the process described by Bishop would infringe -- and, considering the circumstances here disclosed, that is enough to show invalidity of the later patent. *Knapp v. Morss*, 150 U. S. 221, 150 U. S. 228. It lacks novelty. The substance of its disclosures had been revealed by Bishop twenty years earlier. *Sewall v. Jones*, 91 U. S. 171, 91 U. S. 182 *et seq.*

Reversed.